Appl. No. 09/880,612
Amdt. dated: September 29, 2004
Reply to Office action of July 1, 2004

Docket No. 52478-0500

Remarks/Arguments:

Applicant respectfully requests that this response be entered as it places all the claims in condition where they are patentable and/or it reduces or simplifies issues that may be appealed. It should be noted that the amendments contained herein are provided in an attempt to obtain entry of this response in accordance with 37 CFR 1.116 rather than as an acknowledgement of the validity of the rejection of the current Office Action. As such, client reserved the right to re-introduce the subject matter of the previously presented claims at a later point in the prosecution of this or another application.

Applicant acknowledges with appreciation that Claim 7 is allowed. Of the remaining claims, 1-6 are still pending and have been amended herein, and claims 8-90 have been cancelled.

Claims 1-3 were amended to recite: "A method of evaluating whiteness of light emitted from a ~~light source~~ fluorescent lamp, comprising...." Claims 4-6 were amended to recite: "... light emitted from the ~~light source~~ fluorescent lamp...." Support for these amendment is found at least on page 21, in lines 11-16. No new matter was added.

Claims 1, and 2-6 were rejected as being obvious in light of *Ikeda et al* (US5071727, hereinafter *Ikeda*) and/or obvious in light of *Ikeda* in view of *Nishino et al.* (US4469798, hereinafter *Nishino*). The Applicant respectfully disagrees.

In addition to the inadequacies discussed in prior responses in regard to the previous forms of claims 1-6, claims 1-6 are not obvious over *Ikeda* at least because *Ikeda* does not teach, suggest, or motivate a method for evaluating the whiteness of light emitted from a fluorescent lamp. It is highly unlikely that a person of average skill in the art would have turned to a non-analogous patent on toner compounds to find a method for evaluating the whiteness of light from a fluorescent lamp.

Furthermore, the method of *Ikeda* is inappropriate for determining the whiteness of a fluorescent lamp as comparing a compound to a color sample when both are illuminated by a fluorescent lamp does not provide a mechanism for determining the whiteness of the lamp. The match will

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be determined by whether the characteristics of the compound match those of the sample, not by whether the characteristics of the sample match those of the lamp.

Moreover, the Office Action acknowledges that *Ikeda* does not teach the claimed method for determining C, but asserts that it would have been obvious to utilize the claimed method of determining C in the method of determining whiteness of a compound of *Ikeda*. However, it is unclear why one would have a reason to do so when one would still need to determine V, and determining the value for V, i.e. identifying a matching color sample, provides a value for C. As such, the Office Action is asserting that it would be obvious to insert redundant steps into the method without obtaining any benefit from doing so.

The Office Action contends that the equation of claim 1, and the equation of *Ikeda* are the same when V=10. Applicant respectfully disagrees.

The Office Action relies on the assertion that the value V could be any value. However, *Ikeda* teaches that V is a characteristic of the compound as determined by color matching. As such, it cannot take any value, but is limited to the value that corresponds to the sample being evaluated. Moreover, it is unclear whether it even makes sense to determine the value of whiteness of a compound if it has a V value of 10, and the Office Action is silent in regard to whether it is reasonable to do so.

Furthermore, the values of the equations may be equal, but the equations are not the same, even if V=10, a=-1/40, and b=1. Claim 1 recites "calculating whiteness W ...*using* an equation (1)" [emphasis added], not "obtaining a value W equivalent to a value obtainable using an equation (1)".For one to *use* equation (1) when starting with the equation W1, one would have to both set V=10, and then simplify the equation of *Ikeda* to match the claimed equation. Without simplifying the equation, the equations remain different, and claim (1) remains unused, even if V=10. Setting V=10 and simplifying the equation of *Ikeda* such that it matches the claimed equation is not an obvious modification to make. The mere fact that *Ikeda* can be modified to satisfy the claimed method does not render the claimed method obvious unless the prior art also

suggests the desirability of the modification. The Office Action provides no teaching, suggestion, or motivation to modify the equation of *Ikeda* in the manner suggested.

Even if it setting V=10 did cause the method *Ikeda* to satisfy any of the pending claims, setting V to a value that is unrelated to C changes the principle of operation of *Ikeda*, and a modification which changes the principle of operation of a reference cannot be obvious.

It should also be noted that, even if the claimed method for calculating chroma is used in *Ikeda*, and even if the use of V is eliminated as suggested, *Ikeda* would only teach the use of a single value (-1/40) for *a*, and a single value (1) for *b*. As such, it still would not teach or suggest the use of alternative values for *a* and *b* such as -5.3, -3.3, or -4.4 for and 100 for *b*. It also would not teach or suggest determining *a* and *b* using the chroma light from a standard illuminant, and selected values for *W*.

As the Office Action points out, *Ikeda* fails to teach or suggest all the recitations of claims 2-6. The Office Action attempts to overcome the recognized deficiencies of *Ikeda* by combining it with *Nishino*. In doing so, the Office Action asserts that it would have been obvious to choose different values for the coefficients used in *Ikeda*, that the different values could be selected from another whiteness formula, and because that other formula in a particular instance uses a variable having a value of 100, and because another variable is a negative real number, that doing so obviates claims 2-6. However, *Nishino* utilizes a formula for calculating whiteness that is significantly different from the claimed formula and the formula of *Ikeda*. As such, there is no basis for suggesting that the coefficients of *Nishino* can be substituted for those of *Ikeda*, nor is there any reason for doing so since the equations are not equivalent, and *Ikeda* does not contemplate the use of different coefficients.

It is believed that the case is now in condition for allowance, and an early notification of the same is requested. If the Examiner believes that a telephone interview will help further the prosecution of this case, he is respectfully requested to contact the undersigned attorney at the listed telephone number.

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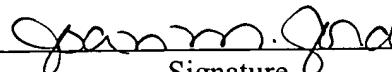
_____ Signature _____

Dated: September 29, 2004

Very truly yours,

SNELL & WILMER L.L.P.

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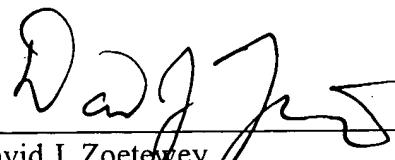
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